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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,511	02/04/2002	Thomas Frederick Enns	747/9-1647	7543

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William J. Sapone
Coleman Sudol Sapone P.C.
714 Colorado Avenue
Bridgeport, CT 06605

EXAMINER

DESANTO, MATTHEW F

ART UNIT PAPER NUMBER

3763

DATE MAILED: 05/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/067,511	ENNS, THOMAS FREDERICK
Examiner	Art Unit
Matthew F DeSanto	3763

Period for Reply

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 31 March 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1,3-9 and 11-16 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,3-9 and 11-16 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kay et al. (USPN 4743231).

Kay et al. discloses a needle device with an L-shaped hollow needle (14), and a body secured to the needle (12), wherein the body includes a spacer (16) and a base (12). (Figures 1-3, and entire reference)

The handles are flexible away from said base. (Figures 2, 3 and entire reference)

The reference also discloses a breathable pad, which extend around the periphery of the base, and wherein the pad is foam, as well as having a flexible tube having one end coupled first portion of said needle.

3. Claims 1, 3, 4, 5, 6, 11, 12, 13, 15, 16 are rejected under 35 U.S.C. 102(b) as being anticipated Marcus by (USPN 4813939).

Marcus discloses a needle device with an L-shaped hollow needle (26), and a body secured to the needle (A), and a flexible tube having one end coupled to the first

portion of said needle wherein the body includes a spacer (B) and a base, and wherein said spacer, base and handles are integral. (Figures 1-3, 5-12 and entire reference)

As to claim 4, 15, wherein said handles include a groove and the groove is a v-shaped (40, 41), for increased flexing of the handles (23, 24). (Figures 11, 12)

As to claims 11, 12, wherein said first portion of said L-shaped needle extends substantially parallel to said base, and second portion of said L-shaped needle extends from said substantially perpendicular to said base, and wherein the needle extends approximately from said center of said base. (Figure 5, 9, and entire reference)

As to claims 13, 14, wherein needle device further comprises a spine (80, A) on the backside of said pair of handles, and wherein said spine includes a needle cover for covering at least a portion of said first portion of said needle and cover unitary with said spacer, base and handles. (Figures 1, 3, 5, 8, 11 and entire reference)

4. Claims 1, and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Raines (UPSN 4631058).

Raines discloses a needle device with an L-shaped hollow needle (10), and a body secured to the needle (14), wherein the body includes a spacer and a base. (Figures 1 and entire reference)

The handles are flexible away from said base.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-9, 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus as applied to claims 1, 3 - 6, 11 - 13, 15, 16 above, and further in view of Kay et al. as applied to claims 1-3 above.

Marcus disclosed the claimed invention but fails to show a breathable pad on said base, and wherein the pad is a foam pad and extends around the periphery of the base.

Kay et al. discloses an L-shaped needle device with a breathable pad, and wherein the pad is foam and extends around the periphery of the base. (Column 5, lines 5-16)

At the time of the invention it would have been obvious to one of ordinary skill in the art to combine the disclosed invention of Marcus with the teachings of Kay et al. because Kay et al. teaches that by using an open cell pad, it allows for antiseptic or antibiotic solution to be supplied to the patients skin, therefore reducing the likelihood of infection, which is an advantage within the medical profession.

Therefore, it would have been obvious to combine Marcus with Kay et al. to obtain the invention as specified in claims 1, 3-9, 11-16.

Response to Arguments

7. Applicant's arguments filed 3/31/03 have been fully considered but they are not persuasive.

8. With regards to Marcus not disclosing a body with a base, a spacer having a first end and a second end and wherein the first end being integral with the base, and the second end being integral with the flexible handles, the examiner disagrees. In Marcus Figures 5, 7, 11, 12, the spacer is reference letter B, with the first end integral to the base (the flat portion), and the second end (the upper portion of B) being integral to the wings.
9. The examiner interprets integral (for Marcus, Kay, and Raines) with respect to the MPEP section 2144.04, {*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice."}
10. With regards to the 103 rejection, motivation is given in Kay et al. Column 2, line 60-62; wherein the pad can be filled with antibiotic cream, thus reducing the likelihood of infection, and therefore making the 103 rejection proper.
11. That the feature of one reference cannot be physically incorporated into the primary reference does not render the combination of references improper. In re Nievelt, 482 F.2d 965, 179 USPQ 224 (CCPA 1973); In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969). The issue is whether the prior art, taken as a whole, would have rendered the claimed subject matter obvious. In re Young, 927 F.2d

588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Conclusion

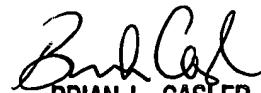
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.


Matthew DeSanto
Art Unit 3763
May 21, 2003


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700